

REMARKS

The Office Action mailed December 23, 2008 has been reviewed and reconsideration of the above-identified application in view of the following amendments and remarks, is respectfully requested

Claims 1-5 are pending and stand rejected.

Claims 1-5 have been amended.

Claims 1 and 5 are independent claims.

Claims 1-5 stand rejected under 35 USC 103(a) as being unpatentable over Kim (USP no. 7, 136, 579, incorrectly referred to as 7,136, 359) in view of Ellis (USP no. 7, 051, 360).

Applicant respectfully disagrees with and explicitly traverses the rejection of the claims.

Kim discloses a system for reproducing a subtitle from an optical recording medium wherein the system reconfigures a subtitle menu during reproducing data from an optical disc and selects the reconfigured menu in order to play the optical disc. Kim discloses selecting a play menu from the optical recording medium to be played, reconfiguring and storing menu execution information and executing the play menu previously reconfigured whenever playing an optical disc. Once a setup menu is reconfigured before or during playing of the disc, the previously configured menu is applied when the optical disc is played again or a new optical disc is played.

Ellis discloses an interactive television program guide which provides a user with the opportunity to select a language for playing television programming and displaying program guide text. Ellis further discloses the selection of a primary language and an alternative language by the user. (see col. 13, lines 2-7). The alternative language may be used when the primary language is not available on the inserted disc (see col. 13, lines 7-11).

In rejecting the claims, the Office Action refers to of Kim for teaching all the elements recited in the claims except for disclosing a list of languages displayed. The Office Action refers to Figure 7b, 182 of Ellis for teaching a list of language displayed

and it would be obvious to incorporate the teachings of Ellis into the system of Kim.

However, contrary to the assertions made by the Office Action, the combination of Kim and Ellis fails to provide a list of languages having a priority in the dynamic menu, as is recited in the claims.

Rather, Kim teaches the ability to preset a language, in a player unit, that enables any disc to be played in the preset language. Ellis discloses a system wherein a primary and an alternative language may be selected from a list of languages and saved for subsequent use when a disc is to be played. The list of languages is displayed from available languages from information on an inserted disc (see col. 12, lines 15-20).

Hence, if the selection of a primary language and an alternative language of Ellis were combined with the teaching of Kim, the combined device would provide a system wherein audio information on inserted discs is played using the selected primary language, if the selected primary language is present on the inserted disc, and with the alternative language if the selected primary language is not present on the inserted discs.

However, the combination of Kim and Ellis fails to provide any teaching for displaying languages that may be on an inserted disc in an order determined by a list of languages as is recited in the claims. Rather the combination of Kim and Ellis merely teaches the playing of a disc in a selected primary language and an alternative language if a primary language is not available.

A claimed invention is *prima facie* obvious when three basic criteria are met. First, there must be some suggestion or motivation, either in the reference themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the teachings therein. Second, there must be a reasonable expectation of success. And, third, the prior art reference or combined references must teach or suggest all the claim limitations.

In this case, the combination of Kim and Ellis fails to disclose the ordering of languages that are present on an inserted disc based on a list of languages that had been determined by the user, as is recited in independent claims 1 and 5. Accordingly, the combination of Kim and Ellis cannot be said to render obvious the subject matter recited in each of the independent claim 1 and 5.

With regard to the remaining claims, these claims depend from one of the respective independent claims, which have been shown to include subject matter not disclosed by the cited references. Accordingly, the remaining claims are also not rendered obvious by the cited references by virtue of their dependency upon an allowable base claim.

For the amendments made to the claims, applicant submits that the reason for the rejection has been overcome and respectfully requests that the rejection be withdrawn.

Applicant would note that the amendments made to the claims have been made to correct the form of the claims and not to overcome the prior art references cited in this matter.

For all the foregoing reasons, it is respectfully submitted that all the claims are in allowable form and the issuance of a Notice of Allowance is respectfully requested.

In the event the Examiner deems personal contact desirable in the disposition of this case, the Examiner is invited to call the undersigned attorney at the telephone given below.

No fees are believed necessary for the timely filing of this paper.

Respectfully submitted,
Michael E. Belk

Date: March 10, 2009

/Carl A. Giordano/
By: Carl A. Giordano
Attorney for Applicant
Registration No. 41,780

Mail all correspondence to:

Michael E. Belk, Registration No. 33357
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9643
Fax: (914) 332-0615

CERTIFICATE OF MAILING UNDER 37 C.F.R. §1.8(a)

The undersigned hereby certifies that this document is being

☐ Transmitted by facsimile to 571 273 8300;

☐ Placed with the US Postal Service with First Class postage attached to the address indicated above;
on March _____, 2009.

Print Name

Signature